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09/878,214	06/12/2001	Jeffrey H. Diamond	0136.0004C	4957

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EXAMINER

GLESSNER, BRIAN E

ART UNIT

PAPER NUMBER

3635

DATE MAILED: 08/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/878,214

Applicant(s)

DIAMOND, JEFFREY H.

Examiner

Brian E. Glessner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2,3,7-19,23-28 and 34-43 is/are allowed.
- 6) ☒ Claim(s) 1,4-6,20-22 and 29-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 20 February 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The following office action is in response to the amendment, remarks, IDS and change of address filed on June 25, 2003. Claims 1-43 are pending in the application. Claims 1, 4-6, 20-22, and 29-33 stand rejected and claims 2, 7-19, 23-28, 34-43 are allowed.

Claim Rejections - 35 USC § 103

1. Claims 1, 4-6 and 20-22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Nesbitt (4,544,587) in view of Pierre (4,423,574).

In regard to claim 1, Nesbitt discloses a structure capable of temporarily protecting a glass pane of a window structure comprising a layer of solidified compressible material capable of providing protection for the glass pane (figure 6). Nesbitt discloses that said material is flexible and pliable, column 3, line 25 and lines 54-59. Therefore, the panel is compressible because in order to bend and be pliable, the panel must compress at least in some areas, i.e. the bent areas. Nesbitt does not specifically disclose the use of a shaping member for removable securing on the window structure to define a cavity over the glass pane. Pierre teaches the use of a shaping member 34, figure 6, used in combination with an insulation means to protect an opening in a wall. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate Pierre's shaping member 34 into Nesbitt's invention, because, as taught by Pierre, the member 34 will "provide structural integrity to the panel", column 4, line 42. The examiner would also like to point out that neither Nesbitt nor Pierre specifically disclose that said compressible material is supplied to said cavity in fluidic form and thereafter solidifies in said cavity. However, this limitation is a method or process step. Thus, since the claim is an apparatus claim, the claim is examined for the final product, i.e. the

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compressible material in a solidified state. The method in which the compressible material got into the cavity is not relevant in an apparatus claim. The examiner would also like to point out that the applicant is only positively claiming a compressible structure comprising a shaping member and a layer of solidified compressible material filling said cavity. The claim does not positively claim the window structure or a cavity over the window structure. Therefore, since Nesbitt in view of Pierre disclose a compressible material in a cavity, the claimed limitations are met.

In regard to claims 4-6, Nesbitt in view of Pierre disclose the basic claimed invention, further including a securing element for removably securing said compressible structure on said window structure. Said securing element includes a releasable adhesive carried by said shaping member, column 3, lines 50-51, or one or more mechanical securing devices, i.e. suction cups, figures 6 and 7, wherein one or more of said securing devices is interposed between a perimeter and said window structure.

In regard to claims 20 and 21, Nesbitt in view of Pierre disclose the basic claimed invention, wherein said layer of solidified compressible material has a thickness in the range of 0.5 inch to 12.0 inches and 1.0 inch to 4.0 inches. Nesbitt discloses that the sheet is from ¼ inch to 1 ½ inches, column 3, lines 66-67. Therefore, Nesbitt's sheet is within the ranges specified by the applicant.

In regard to claim 22, Nesbitt in view of Pierre disclose the basic claimed invention, wherein said member is adjustable in external size in response to a variation in the amount of material in said cavity. Nesbitt discloses that the thickness of the member may be varied.

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Therefore, one could adjust the thickness of the member to any desired amount by merely using more or less layers of material.

2. Claims 29-33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Nesbitt (4,544,587).

In regard to claim 29, Nesbitt discloses a temporarily protected window structure comprising a window structure having a glass pane 30 mounted in a frame 31, and a compressible structure removably secured on said window structure and including a panel of solidified compressible foam material disposed over the glass pane with said panel having a thickness extending perpendicular to said glass pane, figure 6, said thickness being compressible so that it is capable of protecting said glass pane from damage due to storms. Nesbitt discloses that said panel is sufficiently flexible or pliable, column 3, line 25 and lines 54-59. Therefore, the panel is compressible because in order to bend and be pliable, the panel must compress at least in some areas, i.e. where the panel bends. In regard to the foam material, although Nesbitt does not specifically refer to his material as foam, he does state that the material comprises air bubbles, column 4, lines 23-26. Therefore, it is known in the art that foam materials contain such air bubbles. Thus, the examiner contends that said material is foam based on the drawings. In regard to the placement of the panel, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the panel on the exterior of the window, because by doing so, it will protect the window from damage. Also, by having the panel on the outside of the window, it will not be in the way of the occupants on the inside of the structure and will still insulate the window equally well. Finally, it has been held that rearranging parts of

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an invention involves only routine skill in the art. In the instant case, Nesbitt's panel would work equally well if it were placed on the inside or outside of the window.

In regard to claims 30-33, Nesbitt discloses the basic claimed invention, further including a securing element removably securing said compressible structure on said window structure. Said securing element includes one of adhesive, column 3, lines 50-51, or one or more mechanical securing devices, i.e. suction cups, figures 6 and 7, wherein one or more of said securing devices is interposed between a perimeter and said window structure.

Allowable Subject Matter

1. Claims 2, 3, 7-19, 23-28, and 34-43 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: Claims 2, 3, 7-19, 23-28, 34-36, 40, 41, and 43 are allowable for the reasons set forth in the previous office action and claims 37-39 and 42 are allowable for the reasons set forth by applicant in the response filed on June 25, 2003.

Response to Arguments

3. Applicant's arguments filed on June 25, 2003 with respect to claims 1, 4-6, 20-22, and 29-33 is not persuasive.

In regard to claim 1, the applicant argues that Nesbitt discloses two heat insulating sheets 14 and 15 spaced apart from each other by a pair of spaced layers 16 and 17 with a plurality of plastic hemispheres 18 positioned therebetween, but does not disclose the use of a compressible material and a shaping member forming a cavity over the window. As stated in the above rejection, Nesbitt does disclose the use of a compressible material (figure 6) because he states that said material is flexible and pliable, column 3, line 25 and lines 54-59. Therefore, in order

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for the material to bend, it must compress in a thickness direction on the side of the material that would form the concave side after the bend is made, i.e. the left and right side of figure 6 since the material is bent in a somewhat S-shape. If the material did not compress at least slightly, the material would not bend. Once again, the material must compress in order to bend because if it did not, the material would crack or break. While the applicant pointed out the structure of figure 3, and stated that the material is not a compressible material, the examiner would like to point out that Nesbitt does disclose the compressible material in figure 6. The material in figure 6 is not comprised of spaced apart layers as the applicant argued.

In regard to the applicant's argument that Nesbitt and Pierre do not disclose that the shaping member forms a cavity over the window, the examiner would like to point out that the applicant has never positively claimed the window. The applicant only positively claimed a compressible structure comprising a shaping member and a layer of solidified compressible material filling said cavity. The applicant states that the shaping member is "for" defining a cavity over the glass pane. Once again, the applicant did not positively claim the window. Therefore, since Pierre discloses the use of a shaping member having a cavity and, as pointed out above, Nesbitt discloses a compressible material, the claimed limitations are met.

Further, the applicant also argues that Nesbitt and Pierre do not disclose a compressible material supplied to a cavity of a shaping member in fluidic form and thereafter solidifying in the cavity. The examiner would like to point out that this is a method or process step. Thus, since the claim is an apparatus claim, the claim is examined for the final product, i.e. the compressible material in a solidified state. The method in which the compressible material got into the cavity is not relevant in an apparatus claim. The examiner would also like to point out that the

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applicant is only positively claiming a compressible structure comprising a shaping member and a layer of solidified compressible material filling said cavity. The claim does not positively claim the window structure or a cavity over the window structure. Therefore, since Nesbitt in view of Pierre disclose a compressible material in a cavity, the claimed limitations are met.

Claims 4-6 and 20-22 are dependent upon claim 1 and therefore remain rejected as set forth above.

4. In response to applicant's argument pertaining to claim 29, that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

As disclosed above, the examiner contends that Nesbitt's sheet is compressible, because if it were not at least somewhat compressible it would not bend as shown. Further, it is clear from the drawings that the material is a foam material. This is based on the cross-hatching and the bubbles located in the material. Further, the applicant points out that the only reason Nesbitt's member is flexible or pliable is so that it fits immediately adjacent the frame as well as the glass. The examiner would like to point out that in order for the member in figure 6 to fit immediately against the frame and glass, it must compress in the thickness direction to fit into the corner formed between the glass and the frame. If the member did not compress, it would not fit immediately adjacent to the frame and the window. The examiner is not relying on

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hindsight to make this rejection. The examiner is only relying on what is known in the art, i.e. that the drawings clearly show a foam material, and that things must compress at least somewhat in order to be bent as shown by Nesbitt.

Claims 30-33 are dependent upon claim 29 and therefore remain rejected as set forth above.

In regard to the argument pertaining to claim 37, the examiner agrees that Nesbitt and Pierre do not specifically disclose the step of compressing the thickness of the insulating sheet in response to objects forcefully striking the insulating sheet during a storm. Therefore, claims 37-39 and 42 are allowable.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection (i.e. the grounds of rejection pertaining to the added claim limitations) presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Glessner whose telephone number is 703-305-0031.

The examiner can normally be reached on Monday-Friday 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on 703-308-0839. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

B.G.
August 11, 2003

A handwritten signature in black ink, appearing to read "Brian E. Glessner", with a long horizontal flourish extending to the right.

BRIAN E. GLESSNER
PATENT EXAMINER